

REMARKS

In the present application, claims 1-33 are pending. Claims 1-33 are rejected. Claims 1, 2, 8, 9, 10, 16, 17, 23, 24, 25, 31, and 32 have been amended. Claims 2 and 17 have been canceled. As a result of this response, claims 1, 3-16, and 18-33 are believed to be in condition for allowance.

Remarks

The Examiner noted that claims 21 and 22 appear to keep markings from previously presented amendments and requested that this response “include a listing of the claims that corrects these minor informalities.” Such corrections are recited in the listing of the claims.

Claim Rejections - 35 USC § 112

The Examiner rejected claims 1-33 as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner rejected claims 1, 8-10, 16, and 23-25 as “being incomplete for omitting essential steps, such omission amounting to a gap between the steps.” The Examiner identifies the omitted steps as “steps indicating what documents (i.e. smallest/largest) the comparing step should start operating on and what documents the method should stop operating on. It is not clear if the method is only operated on two documents ... It is also unclear what would happen if ‘a given document’ was the largest document. It appears that in this case the claim would not be functional.”

Claim 1 recites:

1. A method for processing data representing documents, comprising:
for individual documents of a set of documents, executing a software program to obtain a list of salient terms found in each document; comparing the list of salient terms for a first document to the list of salient terms for a second document; and
declaring the first document to be substantially identical to, or substantially similar to, the second document if some predetermined number of salient terms are found in each of the

lists of the first document and the second document, wherein the comparing includes sorting the documents into a document list in order of increasing size, and where the step of comparing compares the list of salient terms for a given document with the list of salient terms for the next larger-documents in the document list.

With respect to claim 1, Applicants respectfully respond that the Examiner is incorrect in his interpretation of the requirements for the recitation of the claimed steps. Specifically, the omission of a step indicating upon which document the comparing step should start and stop does not form a proper ground for rejection. Applicant is not obligated to needlessly limit the scope of the claim to include such a step. The scope of claim 1 encompasses comparing the list of salient terms for a first document to the list of salient terms for a second document wherein the first and second documents are subject to the additionally recited elements of the claim. As such, the scope of claim 1 is entirely clear as written and is broadly drawn to comparing any two lists as specified. The mere possibility that the scope of a claim **can** be restricted through the addition of additional limitations does not necessitate the addition of such limitations. In the present case, such a restriction as stated by the Examiner is not “necessary to practice the invention” as stated in MPEP § 2172.01.

Applicants further respectfully assert that the Examiner is incorrect when asserting that “It is not clear if the method is only operated on two documents”. Claim 1 is entirely clear in reciting method steps involving a first and a second document. The method steps clearly define the method as applied to two documents. Application to a plurality of comparisons utilizing a plurality of documents would amount to the repeated application of the recited method of claim 1. There is no requirement that claim 1 recite every possible permutation of various numbers of documents to which the recited method can be applied.

Lastly, Applicants respectfully maintain that the Examiner is in error when asserting that “the claim would not be functional” if “‘a given document’ was the largest document.” A claim functions, in general, to clearly define the metes and bounds of the claimed invention. The mere possibility that someone might perform a method in a

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manner that would prohibit them from performing each and every recited element of
claim 1 does not render the claim unclear.

As a result, Applicants respectfully traverse the Examiner's grounds for rejection with regards to claim 1. Claim 1 is therefore in condition for allowance. For the reasons discussed above with reference to claim 1, all of independent claims 8-10, 16, and 23-25 are likewise in condition for allowance.

With respect to claims 1, 16, and 31, the Examiner asserts that the limitation "the step of comparing compares a given document with next larger-documents in the document list" renders the claims indefinite as it contradicts the earlier recitation of "comparing the list of salient terms for a first document to the list of salient terms for a second document." Claims 1, 16, and 31 are amended herein to recite, as in amended claim 1, "the step of comparing compares the list of salient terms for a given document with the list of salient terms for the next larger-documents in the document list". Claims 1, 16, and 31 are therefore in condition for allowance. The Examiner rejected claims 2-7 and 17-22 as being dependent on rejected independent claims 1 and 16. As claims 1 and 16 are now in condition for allowance, so to are claims 2-7 and 17-22.

The Examiner rejected claims 2 and 17 as being indefinite. Specifically, the Examiner noted that "It is impossible for one of ordinary skill in the art to determine how close to 90% of the terms must be found in each of the lists." The term "about" has been removed from both claims 2 and 17 and, thus, no longer modifies "90%". As a result, any uncertainty regarding this quantity is removed. Claims 2 and 17 are therefore in condition for allowance. In addition, the recitation of a predetermined number equal to about 90% or greater in claim 2 as originally filed has been added to the specification at page 8. No new matter has been added.

The Examiner rejected claims 8 and 23 as being indefinite. The terminology "the step of comparing compares a given document with the next larger documents in the document list" has been amended in both claims to recite the element in definite fashion. No new matter has been added. Claims 8 and 23 are therefore in condition for allowance. The Examiner similarly rejected claims 9 and 24. Claims 9 and 24 have been similarly amended to more definitely recite the claimed elements. Claims 9 and 24 are therefore in condition for allowance. Lastly, the Examiner rejected claims 10, 25, and 32 for reasons

similar to those recited immediately above. Claims 10, 25, and 32 have been amended as described above with reference to, for example, claims 9 and 24, and are in condition for allowance. As claims 11-15, 26-30, and 33 depend upon claims 10, 25, and 32, they are likewise in condition for allowance.

Claim Rejections – 35 USC § 102

The Examiner rejected claims 16-30 as being anticipated by Gomes et al. Claims 16, 23, 24, and 25 were rejected for optionally reciting elements. The Examiner asserted that the claims should be amended to positively recite the steps. While taking no position on the merits of the Examiner's rejection, claims 16, 23, 24, and 25 are amended herein to positively recite the aforementioned claim elements in accordance with the Examiner's requirement. Claims 16, 23, 24, and 25 are therefore in condition for allowance. As all of claims 17-22 and 26-30 are dependent upon claims 16 and 23-25, they are likewise in condition for allowance.

Allowable Subject Matter

The Examiner noted that claims 1, 8-10 and 31-32 would be allowable if rewritten or amended to overcome the rejections under 35 USC § 112. Claims 1, 8-10 and 31-32 have been so amended. Lastly, the Examiner noted that claims 2-7, 11-15, and 33 would be allowable if rewritten to overcome the rejections under 35 USC § 112 and to include all of the limitations of the base claim and any intervening claims. As all of claims 2-7, 11-15, and 33 depend upon claims 1, 10, and 32, they are likewise in condition for allowance.

An earnest and thorough attempt has been made by the undersigned to resolve the outstanding issues in this case and place same in condition for allowance. If the Examiner has any questions or feels that a telephone or personal interview would be helpful in resolving any outstanding issues which remain in this application after consideration of this amendment, the Examiner is courteously invited to telephone the undersigned and the same would be gratefully appreciated.

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It is submitted that the claims herein patentably define over the art relied on by the Examiner and early allowance of same is courteously solicited.

Respectfully submitted:

Jeffrey R. Ambroziak

Reg. No.: 47,387



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Date

Customer No.: 29683

HARRINGTON & SMITH, LLP

4 Research Drive

Shelton, CT 06484-6212

Telephone: (203)925-9400

Facsimile: (203)944-0245

email: jambroziak@hspatent.com

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